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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,251	11/08/2001	Lee Delson Wilhelm	13929.1	5614

23774 7590 10/16/2002

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DOYLESTOWN, PA 18901

EXAMINER

HALPERN, MARK

ART UNIT	PAPER NUMBER
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1731

6

DATE MAILED: 10/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

mk 6

# Office Action Summary

Application No.

10/010,251

Applicant(s)

WILHELM, LEE DELSON

Examiner

Mark Halpern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 8-13, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-13, 21-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_. 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

- 1) Acknowledgement is made of Amendment received 8/13/2002, Paper No. 5. Applicant ~~cancels~~ <sup>amends</sup> claim 8, and offers new claims 21-22, for consideration.

### *Specification*

- 2) Cross-reference section should indicate that application 09/283,502, is now Patent U.S. 6,344,111.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 3) Claim 22 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 22, lines 2-5, recites "...protuberances or depressions sized such that a height of embossing elements which are not used to form visually distinctive icons is less than one-half a thickness of a paper sheet to be embossed, ...". The above is not in the specification.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 8-9, 12-13, 21-22, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz (5,620,776). Schulz discloses an embossed tissue and a roll for embossing that requires less penetration depth than prior art embossing techniques (col. 1, lines 14-20, and 60-67). The depth or height of embossing depression varies from 3 thousands of an inch to 120 thousands of an inch (col. 2, lines 5-24); said dimensions calculate from 0.076 mm to 3.04 mm. The embossing is performed in a small percentage of the surface area of the tissue as shown in Figures 1 and 3, and most embossing is done to a deeper depth than the minimum depth, therefore, it would have been obvious, to one skilled in the art at the time the invention was made, that only a minority of fiber bonds in the tissue be broken in a center 0.02 mm thickness of a tissue paper when the depressions are sized at less than 0.1 mm. The roll produces visible and invisible depressions in the tissue. It would have been obvious, to one skilled in the art at the time the invention was made, that some of the Schulz depressions, especially the depressions of out 0.076 mm depth, be invisible to the unaided human eye.

5) Claims 10-11, are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulz in view of Rheingold (3,563,819). Schulz is applied as above for claim 8,

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Schulz fails to disclose method of making depressions by etching and stippling.

Rheingold discloses method of making depressions by etching and stippling in a metal product. It would have been obvious, to one skilled in the art at the time the invention was made, to combine the teachings of Rheingold and Schulz, because such combination would provide means of creating delicate depressions in the roll of Schulz.

***Response to Amendment***

6) Applicant's arguments filed 8/13/2002, have been fully considered but they are not persuasive.

Applicant alleges that the cited prior art, Schulz, does not recite that the embossing roll produces invisible depressions in the tissues.

Examiner responds as follows. As per item 3 above, Schultz discloses embossing to a depth of from 0.076 mm to 3.04 mm, wherein most embossing is done to a deeper depth than the minimum depth. It would have been obvious, to one skilled in the art at the time the invention was made, that some of the Schulz depressions, especially the depressions of about 0.076 mm depth, be invisible to the unaided human eye.

Applicant alleges that the Schulz range of engraving depth is convenient rather than functional.

Examiner does not consider the motivation of Schultz, as to the range of engraving depth as long as Schulz discloses the engraving depth.

Applicant alleges that the embossing of Schulz covers about 10% of the tissue surface, vs. about 100% area claimed for the present invention.

Examiner responds that the 100% area coverage feature is not claimed.

Applicant alleges that the cited references, Schulz and Rheingold are not combinable because of Schulz deficiencies as discussed above, and because Rheingold application is to metal.

The process of etching or stippling does not depend on the surface on which the above functions are performed. The examiner maintains that the combination of the cited references is proper, as per item 4 above.

### ***Conclusion***

7) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

MH

Mark Halpern  
Patent Examiner  
Art Unit 1731



STEVEN P. GRIFFIN  
SUPERVISORY PATENT EXAMINER  
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October 4, 2002